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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,284	04/05/2005	Martin Morters	268418US0X PCT	4672
22850	7590	07/25/2008	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			SMITH, JENNIFER A	
			ART UNIT	PAPER NUMBER
			1793	
			NOTIFICATION DATE	DELIVERY MODE
			07/25/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/530,284	<b>Applicant(s)</b> MORTERS ET AL.	
	<b>Examiner</b> JENNIFER A. SMITH	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 17, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) 6-11 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 24-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Application***

Claims 1 and 5-6 have been amended.

Claims 12-16 and 18-23 are canceled.

Claims 6-11 and 17 remain withdrawn.

Claims 24-25 are new

Claims 1-5 and 24-25 are presented for examination.

### ***Withdrawal Objections to the Claims and Specification***

The objections to the claims and specification are withdrawn in view of Applicant's amendments to the specification and to claim 1 which replace the phrase "BET surface" with "BET surface area" and now clearly distinguish this property.

### ***Withdrawal of Claim Rejections***

The rejections of claims 1-5 under 35 U.S.C. 102(b) or 35 U.S.C. 103(a) as stated in the Office Action mailed on 11/30/2007 are withdrawn in view of Applicant's amendments.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, and 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Mangold et al. (JP 2000-169132).

In regard to claim 1, the Mangold reference discloses a silicon dioxide powder produced by flame hydrolysis by using an aerosol. The silica powder has the properties BET surface area is 55 m<sup>2</sup>/g, tamped density is 94 g/l, and DBP number is 81 [See Example 1 in Table 2]. The powder is said to be homogeneous [See Claim 2].

In regard to claim 4, the pH value is 4.39 in a 4% aqueous environment [See Table 2].

In regard to claim 5, the Mangold references teaches the silicon dioxide has a DBP absorption of less than or equal to 100 g [See Abstract]. The BET surface area is 55 m<sup>2</sup>/g, tamped density is 94 g/l, and pH is 4.39 [See Example 1 in Table 2].

In regard to new claims 24 and 25, the Mangold reference teaches a material that consists of silica powder which includes 0.21 wt% other materials (impurities) [See Table 3, Example 1]. Because “the transitional phrase “consisting of” is defined as “closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith.” In re Gray, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); Ex parte Davis, 80 USPQ 448, 450 (Bd. App. 1948), the silica powder disclosed by Mangold et al. anticipates claims 24 and 25.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mangold et al. (JP 2000-169132) in view of Evonik Degussa, Physical Properties of Aerosil OX 50.

In regard to claims 2 and 3, the Mangold reference does not teach the average aggregate circumference but does disclose the use of the Aerosil OX 50 product manufactured by Evonik Degussa. The Mangold reference teaches aggregates of the silica powder in Drawing 2.

The average particle size is shown to be 40 nm in the Evonik Degussa product information sheet. A particle size of 40 nm translates to a circumference of about 125 nm for single particles and the groups of particles shown in Drawing 2 are on the micron scale in terms of aggregate diameters. In addition there is a wide range of aggregate particle sizes visible in Drawing 2 - leading to a large kurtosis.

Therefore, it would have been obvious to one of skill in the art, at the time of Applicant's invention, that the silica powder manufactured in the Mangold reference would exhibit such characteristics in terms of aggregate circumference and area with the information presented in the Mangold document and the inherent features of the Aerosil OX 50 product.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-5, filed 04/25/2008, have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues the Hartman fails to teach or suggest the limitations of claim 1. See the new grounds of rejection above.

The Schumacher and Meyer references are not considered prior art as a result of the submitted certified English language translation of priority document DE 102 58 858.9.

### ***Conclusion***

Claims 1-5 and 24-25 are rejected.

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNIFER A. SMITH whose telephone number is (571)270-3599. The examiner can normally be reached on Monday - Friday, 8:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571)272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jerry A Lorengo/  
Supervisory Patent Examiner, Art Unit 1793

Jennifer A. Smith  
July 18, 2008  
Art Unit 1793

JS